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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,490	12/28/2000	Douglas B. Quine	F-238	3256

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EXAMINER	
SALAD, ABDULLAHI ELMI	
ART UNIT	**PAPER NUMBER**
2157	8

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/751,490	QUINE ET AL.	
	Examiner	Art Unit	
	Salad E Abdullahi	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 December 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4-6*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reviewed. Original claims 1-3 are pending. The rejection cited stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "the remote computer" in lines 8, 10 and 11. There is insufficient antecedent basis for this limitation in the claim. It is not clear weather the remote computer as recited in lines 8, 10 and is the same as the remote e-mail correcting computer as recited in line 2.

Also Claim 1 recites the limitation "the remote e-mail forwarding computer" in line 4. There is insufficient antecedent basis for this limitation in the claim. It is not clear weather the remote e-mail forwarding computer as recited in line 4 and is the same as the remote e-mail correcting computer as recited in line 2.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims1 and 2 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 20 and 21 of copending Application No. 09/750,952.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. Claim 1 of the instant application is compared to claim 20 of the co-pending application in the table below.

Instant Application 09/751,490	Co-pending Application 09/750,952
Claim 1: a method for correcting an e-mail message that has been determined as being undeliverable via a remote e-mail correcting computer having a unique e-mail address, the method comprising the steps of:	Claim 20: a method for correcting an e-mail message that has been determined as being undeliverable via a remote e-mail correcting computer having a unique e-mail address, the method comprising the steps of:
prescribing at least one domain name **address** in the remote e-mail forwarding computer by a subscriber;	prescribing at least one domain name in the remote e-mail forwarding computer by a subscriber;
prescribing at least one format for formatting e-mail addresses intended to be sent to the at least one domain name **address**;	prescribing at least one format for formatting e-mail addresses intended to be sent to the at least one domain name;
sending from a user to the remote computer an e-mail message addressed to an intended e-mail address;	sending from a user to the remote computer an e-mail message addressed to an intended e-mail address;

receiving at the remote computer from a senders computer the e-mail message addressed to the intended e-mail address;	receiving at the remote computer from a senders computer the e-mail message addressed to the intended e-mail address;
parsing the intended e-mail address from the e-mail message in the remote computer to determine if the domain name **address** of the e-mail message has been prescribed with the remote computer; and	parsing the intended e-mail address from the e-mail message in the remote computer to determine if the domain name of the e-mail message has been prescribed with the remote computer; and
sending a message to the senders computer indicating the prescribed at least one format for the parsed domain name address if the parsed domain name **address** has been prescribed with the remote computer.	sending a message to the senders computer indicating the prescribed at least one format for the parsed domain name address if the parsed domain name has been prescribed with the remote computer.

As shown in the above table the word "**address**" was added to claim 1, of the instant application:

However, domain name address as used in the instant application claim 1 is synonymous with domain name as used in claim 20 of the co-pending application and the two phrases are interchangeable used in instant application and in the art as a whole. Therefore, Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 20 of copending Application No. 09/750,952.

6. Claim 2 of the instant application is compared with claim 21 of the co-pending application on the table below.

Instant Application 09/751,490	Co-pending Application 09/750,952
Claim 2: a method as recited in claim 1	Claim 21: a method as recited in claim

further including the step of prescribing a plurality of correct usernames for the prescribed domain name **address** in the remote computer.	20 further including the step of prescribing a plurality of correct usernames for the prescribed domain name in the remote computer.

As show above in the above table the only difference between claim 2 of the instant application and claim 21 of the co-pending application is that, the word "address" is added to claim 2 of the instant application.

However, domain name address as used in the instant application claim 2 is synonymous with domain name as used in claim 20 of the co-pending application and the two phrases are interchangeable used in instant application and in the art as a whole. Therefore, Claim 2 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 21 of copending Application No. 09/750,952.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of copending Application No. 09/750,952. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the two claims is that "username associated with the e-mail message" is recited in claim 3 of the instant application instead of "intended e-mail address" as recited in the claim 22 of the co-pending application.

9. Claim 3 of the instant application is compared with claim 22 of the co-pending application on the table below.

Instant Application 09/751,490	Co-pending Application 09/750,952
Claim 3: a method as recited in claim 2 further including the step of determining in the remote computer if there is a closest match between one of the prescribed correct usernames with that of the **username associated with the e-mail message** sent to the remote computer .	Claim 22: a method as recited in claim 21 further including the step of determining in the remote computer if there is a closest match between one of the prescribed correct usernames with that of the **intended e-mail address** sent to the remote computer.

As shown in the above table the only difference between is that username associated with the e-mail message is added to claim 3 of the instant application.

However, the username associated with e-mail message as recited claim 3 of the instant application is analogous with the intended e-mail address which includes a username of the intended e-mail address. Therefore, a person having ordinary skill in the art would have readily recognized the username associated with e-mail address as recited in claim 3 of the instant application is obviously the intended e-mail address as recited in claim 22 of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tusei U.S. Patent No. 6,654,779[hereinafter Tsuei] in view of Reilly U.S. Patent No. 6,427,164[hereinafter Reilly].

As per claim 1, Tsuei discloses a method for correcting an e-mail message that has been determined as being undeliverable via a remote e-mail correcting computer (e-mail address management EAMS 330) having a unique e-mail address, the method comprising the steps of:

- prescribing at least one domain name address in the remote e-mail forwarding computer by a subscriber (registering at least domain name address e.g. OLDISP.com in the EAMS 330 by a recipient 150) (see fig. 3, element 342 and col. 6, lines 17-44).
- prescribing at least one format for formatting e-mail addresses intended to be sent to the at least one domain name address (registering by the recipient 150 the format for the e-mail address e.g. username followed by domain name/ username@OLDISP.COM as shown by 342)(see fig. 3, element 344 and col. 6, lines 17-44);
- sending from a user (sender 110) to the remote computer (EAMS) an e-mail message addressed to an intended e-mail address (old e-mail address) (see fig. 3, element 342 and col. 7, lines 53-57, where a sender 110 sends an e-mail message with an old e-mail address);

- receiving at the remote computer (EAMS 300) from a senders computer the e-mail message addressed to the intended e-mail address (the EMAS 330 receiving from senders 110 an e-mail message with an old e-mail address) (see col. 7, lines 9-14);
- parsing the intended e-mail address from the e-mail message in the remote computer (looking up the old e-mail address from the bounced/undeliverable e-mail message)(see col. 7, lines 9-16 and col. 8, lines 5-17); and
- sending a message to the senders computer indicating the prescribed at least one format (i.e. username followed by domain address as shown on the new e-mail address returned by the EMAS 300) (see col. 7, lines 9-24).

Tsuei, does not explicitly disclose:

determining if the domain name address of intended e-mail address from e-mail message has been prescribed with the remote computer.

Nonetheless, determining if the domain name address of intended e-mail address from e-mail message has been prescribed with the remote computer is well known in the art and would have been an obvious modification to Tusei's system as evidenced by Reilly. Reilly, discloses after an e-mail servers receive an intended e-mail address from an e-mail message, the e-mail servers first parse or check the domain name address of the received e-mail message in a database (that is the data after the sign @, or the domain name address portion of the e-mail) to determine if it is the proper destination (i.e., if the domain name address is registered with e-mail server) before taking any other action (see col. 7, lines 7-13). The advantage of parsing the domain name address first of the

e-mail message is to determine quickly if domain name address (e.g. OLDISP.com) is known to the e-mail server. Furthermore, Tsuei teaches in response to receiving e-mail message containing predetermined e-mail address the EAMS 330 can lookup or parse the e-mail address in the database 38 to determine if intended e-mail address of the e-mail message is associated with a new e-mail address in its database records which obviously includes checking the domain name address portion of the intended e-mail address to determine if the domain name is registered with the EMAS system. Hence, one skilled in the art would have readily recognized by looking up the e-mail addresses in the database 338 in order to determine if the intended e-mail address is associated with any of the e-mail address in its database Tsuei determines if the domain name address of intended e-mail address from e-mail message has been prescribed with the remote computer. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Reilly into Tsuei's system such that the EMAS server 300 can lookup the domain name address of the e-mal messages to determine if it is the proper destination of the e-mail message in order to quickly and efficiently processes the e-mail message, thereby enhancing system response time.

As per claim 2, Tusei discloses the method as recited in claim 1 further including the step of prescribing a plurality of correct usernames for the prescribed domain name address in the remote computer (see fig. 3, elements 340a –340n, which shows a plurality of correct usernames of the domain OLDISP.com and col. 6, lines 31-37).

As per claim 3, Tusei discloses the method as recited in claim 2 further including the step of determining in the remote computer if there is a closest match between one of the prescribed correct usernames with that of the username associated with the e-mail message sent to the remote computer (see col. 9, line 9, lines 59-64, where the EAMS searches its database 338 to determine if there is match between records database i.e., usernames associated with e-mail address in the data database with the e-mail messages)

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) McDowell et al., U.S. Patent No. 6,438,583. Provides an e-mail re-routing system, which enables a user to register with re-route server with his/her old e-mail address.

b)Salzfass et al., U.S. Patent Application Publication No. 2002/0042815. Provides an automated system for routing undeliverable e-mail messages to intended recipient.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 703-308-8441. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should mailed to:

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Abdullahi Salad
Examiner Au 2157
4/1/2004